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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,248	08/17/2000	Peter H. Wolf	WOLF-38176	6241

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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,248

Applicant(s)

WOLF, PETER H.

Examiner

Naeem Haq

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-12,14,15,17-20 and 51-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-12,14,15,17-20 and 51-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This Action is in response to the Applicant's amendment filed on May 11, 2004. Claims 2, 4, 5, 13, 16, and 21-50 have been canceled. Claims 1, 3, 6-12, 14, 15, 17-20, 51-75 are pending and will be considered for examination.

### ***Priority***

Applicant's claim to priority to provisional application 60/163,879 is hereby acknowledged. However, limitations in the current non-provisional application which lack proper written description support in the provisional application are as follows:

Referring to claims 1, 51, 59, and 64, these claims recite the limitation "...substantially the entire body..." This limitation is not disclosed in the provisional application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 51, 59, and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the limitation "...substantially the entire body...." This limitation lacks written description in the specification.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3, 14, 15, 17, 18-20, 51-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imhof (US 5,103,433) in view of Narayanaswami et al. (US 6,504,571 B1) hereinafter referred to as Narayanaswami and further in view of Official Notice.**

Referring to claims 1 and 51, Imhof teaches a process providing event photographs of a sporting event for inspection and selection via a computer, comprising the steps of:

- taking photographs of substantially the entire body of at least one participant of a sporting event along at least one point of a course or field thereof (column 1, lines 7-25; column 2, line 64 – column 3, line 40; column 8, line 33 – column 9, line 28; Figure 3);
- associating identifying data with each photograph taken wherein the identifying data is a time, including hour and minute the photograph was taken (Abstract; column 9, lines 29-38; Figure 3);

- displaying the photograph of the sporting event participant for inspection

(Figure 1, item "11"; column 8, line 59 – column 9, line 4).

Imhof does not teach informing the sporting participants of the identifying data, transferring the photographs to a computer network server, cataloging each of the photographs in a website server according to the identifying data, accessing the server at a location other than the sporting event and searching for a photograph of a particular sporting event participant utilizing the identifying data. However, Imhof teaches that his invention includes a computer connected between the camera and the printer to process the images received from the camera (column 13, lines 18-30). Therefore, Imhof's invention converts the pictures received from the camera into digital format otherwise the computer would not be able to perform the processing disclosed in Imhof's specification. Narayanaswami teaches a method for querying (i.e. searching) digital images stored in a database. Specifically, Narayanaswami teaches accessing a remote sever and searching for a photograph utilizing the identifying data such as date and time (Abstract; column 1, lines 16-26; column 3, lines 56-65; column 7, lines 17-45; column 10, lines 48-61). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Narayanaswami into the method of Imhof. One of ordinary skill in the art would have been motivated to do so in order to perform an efficient search and retrieval of digital images stored in remote servers as taught by Narayanaswami (column 2, lines 15-19). The Examiner notes that both Imhof and Narayanaswami are directed to the field of capturing images from a camera and using a computer to record various types of data

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onto the digital images. Narayanaswami goes on to discuss archiving the images in a database for querying at a later time. Therefore, Imhof and Narayanaswami are analogous art and it is well within the level of one of ordinary skill in the art to incorporate the database and other teachings of Narayanaswami into the invention of Imhof. The Examiner also notes that one of the most important features of any computer system is the ability to store, retrieve, and process data. Since Imhof does not address the issue of storage and retrieval, one of ordinary skill in the art would look to Narayanaswami for a possible solution. Moreover, one of ordinary skill in the art would recognize that the combination of Imhof and Narayanaswami would have a reasonable chance for success since the incorporation of Narayanaswami's teachings into Imhof's invention would not alter the technical characteristics of either invention in such a way as to render either one inoperative. Imhof and Narayanaswami do not explicitly teach informing the sporting participants of the identifying data. However, the Examiner notes that in most sporting events such as marathons, participants take great pride in remembering their finish time. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to inform the participant of Imhof's sporting event of the official finish time. One of ordinary skill in the art would have been motivated to do so in order to allow the participant to record his or her finish time. Furthermore, Narayanaswami repeatedly teaches allowing a user to search a database for an image using date and time. Hence, the user must have had possession of this information prior to the time of searching. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this

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teaching into the method of Imhof. One of ordinary skill in the art would have been motivated to do so in order to allow a user to perform a search of a digital image using the date and time as taught by Narayanaswami. Imhof does not teach transferring the photographs to a computer network server. However, Narayanaswami teaches that the images obtained from the image capturing device (Figure 1, item "100") can be transferred to a database via modem (column 8, lines 40-47). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this teaching into the method of Imhof. One of ordinary skill in the art would have been motivated to do so in order to archive the image for query as taught by Narayanaswami. Imhof does not teach cataloging each of the photographs in a website server according to the identifying data. However, Narayanaswami teaches indexing (i.e. cataloging) the images in a database according to date and time (Abstract).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Narayanaswami into the method of Imhof. One of ordinary skill in the art would have been motivated to do so in order to perform an efficient search and retrieval of digital images stored in remote servers as taught by Narayanaswami (column 2, lines 15-19). Finally, Imhof and Narayanaswami do not teach a website sever or ordering the images. However, Official Notice is taken that it is old and well known in the art to use a website and to place an order through a website. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior

art. One of ordinary skill in the art would have been motivated to do so in order to exploit the power of the World Wide Web for commercial purposes.

Referring to claims 3, 52, Imhof and Narayanaswami do not explicitly teach the step of posting the identifying data associated with each photograph. However, Narayanaswami repeatedly teaches allowing a user to search a database for an image using date and time. Hence, the user must have had possession of this information prior to the time of searching. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this teaching into the method of Imhof. One of ordinary skill in the art would have been motivated to do so in order to allow a user to perform a search of a digital image using the date and time as taught by Narayanaswami.

Referring to claims 14 and 53, Narayanaswami teaches searching for a photograph based on date and time (Abstract). Although Narayanaswami does not explicitly disclose searching based on an approximate time, it would have been obvious to do so. Narayanaswami places no restriction on the date and time used for searching the database. Furthermore, one of ordinary skill in the art would have been motivated to use an approximate time in order to avoid having to remember the exact second of the particular event.

Referring to claims 15 and 54, these claims are dependent on claims 14 and 53 which recite conditional statements such as "when" and "can". These conditional statements render the limitations of claims 15 and 54 as optional because they need not be performed. Therefore claims 15 and 54 are given little patentable weight and do not



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patentably distinguish the claimed invention from the prior art. *"When a claim covers several structures of composition, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art"* (*Brown v. Air Products and Chemicals Inc.*, Fed. Cir., No. 00-1552).

Referring to claims 17 and 55, Imhof teaches that the step of providing a digital camera electronically connected to a computer (column 13, lines 18-21). Imhof does not teach downloading the photographs from the event to the server. However, Narayanaswami teaches a digital camera connected to a computer (Figure 1, items "128" and "104"), and server for immediate download of photographs to the server (column 8, lines 40-47; column 10, lines 48-61). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Narayanaswami into the method of Imhof. One of ordinary skill in the art would have been motivated to do so in order to archive the images for query as taught by Narayanaswami.

Referring to claims 18-20 and 56-58, the cited prior art does not teach fulfilling an order for a photograph via mail or electronic transfer. However, Official Notice is taken that it is old and well known in the art to fulfill a customer's order via mail or electronic transfer. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to use well-known delivery channels for commercial purposes.

**Claims 1, 3, 6-12, 17, and 59-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sigel et al. (US 6,545,705 B1) in view of Narayanaswami et al. (US 6,504,571 B1) hereinafter referred to as Narayanaswami and further in view of Official Notice.**

Referring to claims 1, 3, 6-9, 17, 59, 60, 64-68, and 72, Sigel teaches a process providing event photographs of a sporting event for inspection, selection, and distribution via computer network, comprising the steps of:

- taking photographs of substantially the entire body of at least one participant of a sporting event along at least one point of a course or field thereof (Abstract, lines 2-8; Figure 1, items "12" and "12a"; Figure 3);
- associating identifying data with each photograph taken, wherein the identifying data is a code acquired from a component worn by the participant or a number corresponding to a number worn by the participant (Abstract, lines 21-29; column 2, lines 58-67; column 12, lines 24-35);
- transferring the photographs to a computer network server (column 6, lines 13-16; column 7, lines 6-34; Figure 1, item "10");
- cataloging each of the photographs in a server according to the identifying data (column 7, lines 6-10);
- accessing the server and searching for a photograph of a particular sporting event participant utilizing the identifying data (column 7, lines 6-10);

- displaying the photograph of the sporting event participant for inspection (Figure 7, lines 13-19).

Sigel does not explicitly disclose informing the sporting participants of the identifying data. However, this limitation is inherent in the process of Sigel. Sigel teaches that each contestant has a number on his or her jersey (Abstract, lines 21-29; column 12, lines 50-54). Therefore each contestant is informed of the identifying data because each contestant is aware of the number on his or her jersey. Sigel does not explicitly disclose that the sever is accessed via a remote terminal (i.e. at a location other than the sporting event). However, Narayanaswami teaches accessing a server via a remote terminal and searching for a photograph utilizing identifying data (Abstract; column 1, lines 16-26; column 3, lines 56-65; column 7, lines 17-45; column 10, lines 48-61).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Narayanaswami into the method of Sigel. One of ordinary skill in the art would have been motivated to do so in order to provide access via a plurality of remote terminals such as PDAs and notebooks as taught by Narayanaswami. Finally, Sigel and Narayanaswami do not teach a website sever or ordering the images. However, Official Notice is taken that it is old and well known in the art to art to use a website and to place an order through a website.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to exploit the power of the World Wide Web for commercial purposes.

Referring to claims 10-12 and 69-71, the cited prior art does not teach that the component includes an inductive circuit, or an active component that includes an electronic device having a transmitter. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate these features into the invention of Sigel and Narayanaswami. Applicant has not disclosed that devices provide an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with devices used by Sigel because they also uniquely identify participants in a sporting event. Therefore, it would have been obvious to one of ordinary skill in this art to modify Sigel to obtain the invention as specified in the claims.

Referring to claims 61-63 and 73-75, the cited prior art does not teach fulfilling an order for a photograph via mail or electronic transfer. However, Official Notice is taken that it is old and well known in the art to fulfill a customer's order via mail or electronic transfer. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to use well-known delivery channels for commercial purposes.

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

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### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

September 25, 2004



Jeffrey A. Smith  
Primary Examiner